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In re Application of
ELLIOTT et al.
Application No.: 10/525,743
PCT No.: PCT/US03/26988
Int. Filing Date: 26 August 2003
Priority Date: 30 August 2002
Attorney Docket No.: 059314-0701
For: IMMUNE RESPONSE ASSOCIATED
PROTEINS

DECISION ON REQUEST
UNDER 37 CFR 1.497(d)

This is a decision on applicants' Petition entitled "Change of Inventorship in Accordance with 37 CFR 1.497(d)", filed on 27 September 2005 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to delete all inventors except Vicki S. Elliott as inventors in the above referenced application.

BACKGROUND

On 28 February 2005, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee.

On 11 August 2005, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) & (b), was required.

On 27 September 2005, applicant filed a petition under 37 CFR 1.497(d) for correction of inventorship, to delete all inventors except Vicki S. Elliott. In addition to the \$130 petition fee, Petitioner provided the statements of inventors Thomas W. Richardson, Anita Swarnakar, Joseph P. Marquis, Shanya D. Becha, Soo Yeun Lee, Narinder K. Chawla, Jayalaxmi Ramkumar, April J.A. Hafalia, and Reena Khare in support of the correction of inventorship under 37 CFR 1.497(d). A declaration executed by sole inventor Vicki S. Elliott was also provided.

DISCUSSION

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added or deleted as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(I); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s).

37 CFR 1.497(d) states, in part:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set

forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor . . . that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

The processing fee of \$130.00 has been paid, satisfying Item (2) above.

With regard to Item (3), there is no indication that an Assignment of Patent Application by the inventors has occurred. Thus, Item (3) above is not applicable.

With respect to Item (1) above, the published International application named Vicki S. Elliott, Erika A. Lindquist, Thomas W. Richardson, Anita Swarnakar, Joseph P. Marquis, Shanya D. Becha, Soo Yeun Lee, Narinder K. Chawla, Jayalaxmi Ramkumar, April J.A. Hafalia, and Reena Khare as inventors Applicants provided statements signed by Thomas W. Richardson, Anita Swarnakar, Joseph P. Marquis, Shanya D. Becha, Soo Yeun Lee, Narinder K. Chawla, Jayalaxmi Ramkumar, April J.A. Hafalia, Reena Khare as joint inventors. Each of these respective inventors stated: "I am being deleted as an inventor from the above-captioned application due to amendment of the application upon entry to the U.S. National Stage under 35 U.S.C. 371. Therefore, the change in the inventive entity from the International Application to the U.S. National Stage application occurred without deceptive intention". This statement satisfies item (1) of 37 CFR 1.497(d) with respect to these inventors.

The published International application named Vicki S. Elliott and Erika A. Lindquist as co-inventors. The petition was accompanied by a declaration executed by Ms. Elliott. However, the petition was not accompanied by a statement from Erika A. Lindquist requesting deletion of her inventorship. Moreover, there is no communication from the International Bureau (that is, Form IB/306) indicating that Ms. Lindquist was removed as an applicant/inventor under PCT Rule 92*bis* during the international phase.

Accordingly, applicant has met all of the requirements to remove Thomas W. Richardson, Anita Swarnakar, Joseph P. Marquis, Shanya D. Becha, Soo Yeun Lee, Narinder K. Chawla, Jayalaxmi Ramkumar, April J.A. Hafalia, and Reena Khare as co-inventors in the above-identified international application. However, Ms. Lindquist remains an inventor for the above referenced application and therefore, a declaration or oath, in compliance with 37 CFR 1.497(a) and (b) is required to fulfill the requirements of 35 U.S.C. 371(c). In the alternative, a renewed petition is necessary, providing either the Form IB/306 noting the removal of Ms. Lindquist as an inventor or a statement of Ms. Lindquist requesting her deletion as an inventor.

CONCLUSION

For the reasons discussed above, the submission under 37 CFR 1.497(d) to all inventors except Vicki S. Elliott is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.497(d) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.497(d)." No petition

fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

The renewed petition should provide either: a copy of the Form IB/306 regarding the International Bureau's removal of Ms. Lindquist as an inventor or the appropriate statement from Ms. Lindquist requesting her deletion as a named inventor. In the alternative, a declaration or oath, in compliance with 37 CFR 1.497(a) and (b), and executed by applicant/inventor Erika A. Lindquist, is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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